

**IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF PENNSYLVANIA**

CSB-SYSTEM INTERNATIONAL INC.,

Plaintiff/Counterclaim Defendant,  
v.

SAP AMERICA, INC.,

Defendant/Counterclaim Plaintiff.

Civil Action No. 10-CV-2156-RB

**SAP'S OPPOSITION TO CSB'S MOTION FOR SUMMARY JUDGMENT  
OF NO INDEFINITENESS OF U.S. PATENT NO. 5,631,953**

CSB's Motion For Summary Judgment Of No Indefiniteness wholly fails to mention that there is a fully-briefed, pending motion for summary judgment that all of the claims of the '953 patent *are invalid as indefinite*. In particular, on August 12, 2011, SAP filed a Motion For Summary Judgment Of Invalidity Of Each Claim Of U.S. Patent No. 5,631,953 For Claiming Both An Apparatus And A Method (D.I. 66). SAP's motion explicitly sought summary judgment that all of the claims of the '953 patent are *invalid as indefinite* for failing to meet the definiteness standards of 35 U.S.C. § 112, second paragraph, because they cover both an apparatus and method of use within the same claim. The Federal Circuit has made clear that, as a matter of law, such a claim "is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved' and is 'ambiguous and properly rejected' under section 112, paragraph 2." *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005) (quoting *Ex Parte Lyell*, 17 U.S.P.Q.2d 1548, 1550-51 (BPAI 199)). That motion was fully briefed as of September 23, 2010, and has been pending before the Court since that time.

SAP incorporates herein by reference its briefing on that motion (both opening and reply).<sup>1</sup> For the reasons set forth in its memorandum, SAP believes its motion should be granted. If granted, SAP's indefiniteness motion provides a complete defense to liability.

Because SAP's previously-filed Motion For Summary Judgment Of Invalidity Of Each Claim Of U.S. Patent No. 5,631,953 For Claiming Both An Apparatus And A Method compels a

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<sup>1</sup> SAP also incorporates by reference its Statement of Undisputed Facts in connection with its Motion for Summary Judgment Of Invalidity Of Each Claim Of U.S. Patent No. 5,631,953 For Claiming Both An Apparatus And A Method. For purposes of responding to CSB's motion, SAP does not necessarily agree with or concede any of the facts set forth in CSB's Statement of Undisputed Facts. Any dispute regarding those proposed facts is moot because SAP is not planning to pursue those theories of indefiniteness at trial.

finding that all claims of the '953 patent *are* indefinite, CSB's Motion For Summary Judgment Of *No* Indefiniteness should be denied and SAP's Motion for Summary Judgment Of Invalidity Of Each Claim Of U.S. Patent No. 5,631,953 For Claiming Both An Apparatus And A Method should be granted.<sup>2</sup>

Date: February 10, 2012

Respectfully submitted,

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<sup>2</sup> Although the substance of CSB's motion is drawn specifically to SAP's defense of invalidity based on indefiniteness, its accompanying [Proposed] Order is too broad, seeking to dismiss "SAP's Second Affirmative Defense and Counterclaim II." SAP's Second Affirmative Defense and Counterclaim II plead several defenses not subject of CSB's motion for summary judgment, such as invalidity under §§ 102 and 103. For this independent reason, SAP objects to CSB's Proposed Order.

**CERTIFICATE OF SERVICE**

I hereby certify that on this 10<sup>th</sup> day of February, 2012, I caused a true and correct copy of the foregoing SAP'S OPPOSITION TO CSB'S MOTION FOR SUMMARY JUDGMENT OF NO INDEFINITENESS to be served via CM/ECF on the following attorneys of record:

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